



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

mm

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/642,355

08/14/2003

William E. Sobel

SYMAP024

1616

35833 7590 03/07/2007
VAN PELT & YI LLP
10050 N. FOOTHILL BLVD.
SUITE 200
CUPERTINO, CA 95014

EXAMINER

NGUYEN, MERILYN P

ART UNIT

PAPER NUMBER

2163

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
--	-----------	---------------

3 MONTHS

03/07/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/642,355

Applicant(s)

SOBEL, WILLIAM E.

Examiner

Marilyn P. Nguyen

Art Unit

2163

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-5,7-13,26 and 30-45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-5,7-13,26 and 30-45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 August 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☒ Other: Detailed action.

DETAILED ACTION

1. In response to the communication dated 01/30/2007, claims 1, 3-5, 7-13, 26 and 30-45 are pending in this application as the result of the cancellation of claims 2, 6, 14-25 and 27-29 and the addition of claims 30-45.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 01/30/2007 has been entered.

Claim Objections

3. Claim 34 is objected to because of the following informalities: the claim recites "(Previous presented). A method as recited in claim 1 wherein the image is a system image" which Examiner believes that it is a typo mistake. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 2163

4. Claims 1, 3-5, 7-13, 26 and 30-45 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1, 26 and 34, It's not clear how is the claim directed to a "method for rolling a computer resource back to a state associated with a computer image" and how the claim limitations support the preamble. The claims only recite determining a roll-back state associated with the computer image, determining whether the roll-back state is secure, and performing one or more remediation actions if it is determined that the roll-back state is not secure without any step describing the rolling back function of computer resource. The claim is missing what is going to happen if it is determined that the roll-back state is secure.

Regarding claims 7 and 8, the claims recite "marking a first portion of a repository" (claim 7) and "reverting a second portion of the repository" (claim 8) which render the claims vague and incomplete as how these steps, especially "repository", relate to the method of rolling back a computer resource and how these steps relate to the other steps in the claim.

All other claims are rejected under 112 for failing to solve the deficiencies of claims 1, 26 and 34 from which it depends.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1, 3-5, 7-13, 26 and 30-45 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As set forth in MPEP 21 06(II)A:

Identify and understand Any Practical Application Asserted for the Invention The claimed invention as a whole must accomplish a practical application. That is, it must produce a "useful, concrete and tangible result." State Street, 149 F.3d at 1373, 47USPQ2d at 1601-02. The purpose of this requirement is to limit patent protection to inventions that possess a certain level of "real world" value, as opposed to subject matter that represents nothing more than an idea or concept, or is simply a starting point for future investigation or research (Brenner v. Manson, 383 U.S. 519, 528-36, 148 USPQ 689, 693-96),¹ In re Ziegler, 992, F.2d 1 197, 1200-03, 26 USPQ2d 1600, 1603-06 (Fed. Cir. 199334. Accordingly, a complete disclosure should contain some indication of the practical application for the claimed invention, i.e., why the applicant believes the claimed invention is useful.

Apart from the utility requirement of 35 U.S.C. 101, usefulness under the patent eligibility standard requires significant functionality to be present to satisfy the useful result aspect of the practical application requirement. See Arrhythmia, 958 F.2d at 1057, 22 USPQ2d at 1036. Merely claiming nonfunctional descriptive material stored in a computer-readable medium does not make the invention eligible for patenting. For example, a claim directed to a word processing file stored on a disk may satisfy the utility requirement of 35 U.S.C. 101 since the information stored may have some "real world" value. However, the mere fact that the claim may satisfy the utility requirement of 35 U.S.C. 101 does not mean that a useful result is achieved

Art Unit: 2163

under the practical application requirement. The claimed invention as a whole must produce a "useful, concrete and tangible" result to have a practical application.

The claimed invention is subject to the test of State Street, 149 F.3d at 1373-74, 47 USPQ2d at 1601-02. Specifically State Street sets forth that the claimed invention must produce a "useful, concrete and tangible result". The Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility states in section IV C. 2 b. (2) (on page 21 in the PDF format):

The tangible requirement does not necessarily mean that a claim must either be tied to a particular machine or apparatus or must operate to change articles or materials to a different state or thing. However, the tangible requirement does require that the claim must recite more than a §101 judicial exception, in that the process claim must set forth a practical application of that §101 judicial exception to produce a real-world result. Benson, 409 U.S. at 71-72, 175 USPQ at 676-77 (invention ineligible because had "no substantial practical application").

In the present case, claimed invention (Claims 1, 26 and 34) recites a method for rolling a computer resource back to a state associated with a computer image comprising determining a roll-back state associated with the computer image, determining whether the roll-back state is secure and performing one or more remediation actions prior to or during a roll-back of the computer resource to the roll-back state if it is determined that the roll-back state is not secure which do not provide useful and tangible results as to whether their execution accomplishes a practical application. In order for the claim to be tangible, it must have real world value rather than being an abstract result. The claim contains software per se which is not tangible. For examiner, a tangible result is not attained after performing one or more remediation actions.

Art Unit: 2163

Also, there are no steps describe the rolling back function introduced in the preamble. What is going to happen if the roll-back state is secure? Moreover, merely recite determining and performing steps does not satisfy the useful result aspect of the practical application requirement.

In the present case, claimed invention (Claim 26) recites a computer readable medium that is defined in the Applicant's specification broader to read on signals embodied on a carrier wave (Page 14, line 11 and page 16, line 15). Signals embodied on a carrier wave is not a process, a machine, manufacture, nor composition of matter, thus is a non-statutory subject matter.

All other claims are rejected under 101 for failing to solve the deficiencies of claims 1, 26 and 34 from which it depends.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 3-5, 7-13, 26 and 30-45 are rejected under 35 U.S.C. 102(b) as being anticipated by Colligan (US 6,298,443).

Regarding claims 1, 26 and 34, Colligan discloses a method, a system (See Fig. 4) a computer program product for rolling a computer resource back (restoration) to a state associated with a computer image (See col. 5, lines 4-9, col. 7, lines 40-64) comprising:

Art Unit: 2163

- determining a roll-back state associated with the computer image (See col. 5, lines 4-9);
- determining whether the roll-back state is secure (See col. 9, lines 1-22); and
- performing one or more remediation actions prior to or during a roll-back of the computer resource to the roll-back state if it is determined that the roll-back state is not secure (See col. 9, lines 4-5 and 15-18).

Regarding claims 3-5 and 35-36, Colligan discloses wherein the image is a system image, a file or an application image (See Fig. 1 and col. 9, lines 44-46).

Regarding claim 7, Colligan discloses marking a first portion of a repository (See col. 9, lines 14-22).

Regarding claim 8, Colligan discloses reverting a second portion of the repository (See col. 9, lines 14-22).

Regarding claims 9 and 37, Colligan discloses wherein evaluating a security definition in a repository providing data to the roll-back state (See col. 6, lines 25-59).

Regarding claims 10 and 38, Colligan discloses determining whether the definition is updated (See col. 6, lines 25-26).

Art Unit: 2163

Regarding claims 11 and 39, Colligan discloses retrieving an updated definition if the definition is not updated (See col. 6, lines 25-26).

Regarding claims 12 and 40, Colligan discloses installing the updated definition if the definition is not updated (See col. 6, lines 25-26).

Regarding claims 13 and 41, Colligan discloses wherein performing one or more remediation actions includes displaying a message (See col. 9, lines 3-4) and receiving a user input (See col. 9, lines 4-6).

Regarding claims 30 and 42, Colligan discloses wherein performing one or more remediation actions includes displaying a warning to a user (See col. 9, lines 3-4).

Regarding claims 31 and 43, Colligan discloses wherein performing one or more remediation actions includes stopping the roll-back during the roll-back of the computer resource (See col. 9, lines 5-10).

Regarding claims 32 and 44, Colligan discloses wherein the remediation actions may be configured by a user, system/network administrator, or other person (See col. 9, lines 5-10).

Regarding claims 33 and 45, Colligan discloses wherein performing one or more remediation actions includes retrieving updated security definitions (See col. 9, lines 14-21).

Art Unit: 2163

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Pritchard U.S Patent No. 6,931,552 discloses apparatus and method for protecting a computer system against computer viruses and unauthorized access.

Hugard U.S Patent No. 5,745,669 discloses system and method for recovering pc configurations.

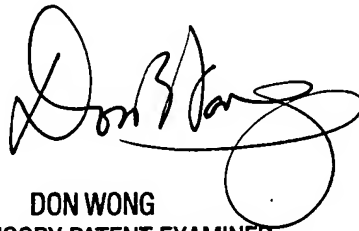
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marilyn P Nguyen whose telephone number is 571-272-4026.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Don Wong can be reached on 571-272-1834. The fax phone numbers for the organization where this application or proceeding is assigned are 571-273-8300 for regular communications and 703-746-7240 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.



MN
February 21, 2007



DON WONG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100